

REMARKS

Claims 66-117 have been introduced by this amendment and are the only claims pending in this application. Claims 15-65 were previously pending in this application, but claims 15-65 were all withdrawn by the Office. The subject matter of original claim 1 and previously amended claims have been reintroduced as new claims 66-117. No new matter has been added.

The Office communication dated January 6, 2010 indicated that the previously submitted claims 15-65 are allegedly directed to an invention that is independent or distinct from the invention originally claimed. As such, the Office withdrew claims 15-65 pursuant to 37 CFR 1.142(b) and MPEP § 821.03. Applicants respectfully traverse.

While the Office has withdrawn claims 15-65 on a unity of invention basis under PCT Rules 13.1 and 13.2, the notion of a single inventive concept was incorrectly applied.

Applicants note that the determination of a special technical feature “is made based on the contents of the claims as interpreted in light of the description and drawings.” MPEP s. 1850 at p. 1800-98, col 2; see also id. at pp. 1800-98 through 1800-99. The description makes clear that the special technical feature is the combination of a magnetic material with a peptide in a cell. (CITE). The description does not in any way assert that the single general inventive concept is the cell and a magnetic particle (excluding a peptide), as asserted in the Notice.

Moreover, the lack of unity of invention “should neither be raised nor maintained on the basis of a narrow, literal or academic approach.” MPEP s. 1850 at p. 1800-99, col. 1. Rather, it should take into account a “broad, practical consideration of the degree of interdependence of the alternatives presented, in relation to the state of the art.” Id. The allegation that the general inventive concept, and thus the special technical feature, is the cell and a magnetic particle (excluding a peptide), is based on a narrow and literal approach and ignores both the practical recognition of the description and the teaching of the prior art that the combination of a cell and a magnetic particle (excluding a peptide) was known.

If there is any doubt whether “the common matter of the independent claims is well known and the remaining subject matter of each claim differs from that of the others without there being any unifying novel inventive concept common to all” (in which case there is no unity) or whether

"there is a single general inventive concept that appears novel and involves inventive step" (in which case there is unity), the Office should not raise a unity objection. MPEP s. 1850 at p. 1800-99, col. 1. Such a situation should be resolved in favor of unity, with "the benefit of any doubt being given to the applicant." MPEP s. 1850 at p. 1800-99, col. 2.

Moreover, whether a group of claims is linked as to form a single general inventive concept is a determination that applies to different *categories* of claims. The MPEP 1893.03(d) sets forth that "[t]he principles of unity of invention are used to determine *the types of claimed subject matter and the combinations of claims to different categories* of invention that are permitted to be included in a single international or national stage patent application." (Emphasis added.)

Applicants wish to point out that unity of invention under 37 CFR 1.475 before the International Searching Authority, the International Preliminary Examining Authority and during the national stage applies to "an international or a national stage application containing claims to different categories of invention." The same section also sets forth that unity of invention exists if the claims are drawn only to one of the following combinations of categories:

- (1) A product and a process specially adapted for the manufacture of said product; or
- (2) A product and a process of use of said product; or
- (3) A product, a process specially adapted for the manufacture of the said product, and a use of the said product; or
- (4) A process and an apparatus or means specifically designed for carrying out the said process; or
- (5) A product, a process specially adapted for the manufacture of the said product, and an apparatus or means specifically designed for carrying out the said process.

In the instant case, the previously submitted claims (claims 15-65) did not introduce new categories of claims that were not embraced by the original set of claims (claims 1-14). Instead, claims 15-65 were merely presented as new claims for the sake of simplicity. They incorporate into independent claims limitations from dependent claims to overcome the Office's rejections based on the cited prior art, as well as to correct formalities in response to claim objections.

More specifically, original claim 1 is a *composition* claim directed broadly to "a magnetic cell comprising a magnetic particle held on the surface of the cell." The Office cited Margolis et al. and argued that the reference teaches every element thereby anticipating of the claim. In response,

Applicants amended the claim and presented as new claim 65, which is also a *composition* claim, which incorporates an element of original claim 2 and additional limitations. Applicants direct the Examiner's attention to the previously submitted Response to Office Action, page 11. Thus, contrary to the Office's allegation, claim 65 is indeed directed to the same subject matter originally elected but only narrower in scope. In other words, original claim 1 fully embraces the scope of claim 65 previously submitted. Claim amendments that narrow the scope of an original claim so as to overcome a cited prior art reference do not invoke lack of unity. Accordingly, Applicants respectfully submits that constructive election was triggered improperly where unity of invention exists.

In addition, Applicants submit that the previously presented set of claims (claims 15-65) includes a special technical feature that was not recited in the original set of claims (claim 1-14). See MPEP 1850. II. "The expression special technical feature is defined in PCT Rule 13.2 as meaning those technical features that define a contribution which each of the inventions, considered as a whole, makes over the prior art." In the instant case, the amended set of claims includes "a peptide which has an amino acid sequence comprising RGDS or GRGDS" which was not recited in the original set of claims. As stated in the previous response, the limitation was added to overcome Margolis et al. Accordingly, the subject matter of claims 15-65 is properly joined and is novel over the cited art.

Notwithstanding, in light of withdrawal of claims 15-65 as set out in the Office Communication of January 6, 2010, Applicants herein present a new set of claims (claims 67-117) directed to the same subject matter of the withdrawn claims. Claim 66 is identical to the previously canceled claim 1, and claim 67 is identical to previously presented claim 15 except written as a dependent claim so as to clarify that the subject matter embraced by the claim does not embody a separate invention as explained above.

Applicants believe that the Amendments and Arguments provided herein fully address the Office's objections and that the claims are in an allowable condition. A favorable response is earnestly solicited.

CONCLUSION

A Notice of Allowance is respectfully requested. The Examiner is requested to call the undersigned at the telephone number listed below if this communication does not place the case in condition for allowance.

If this response is not considered timely filed and if a request for an extension of time is otherwise absent, Applicant hereby requests any necessary extension of time. If there is a fee occasioned by this response, including an extension fee, the Director is hereby authorized to charge any deficiency or credit any overpayment in the fees filed, asserted to be filed or which should have been filed herewith to our Deposit Account No. 23/2825, under Docket No. T0509.70012US00.

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Respectfully submitted,

By Helen C. Lockhart

Helen C. Lockhart
Registration No.: 39,248
WOLF, GREENFIELD & SACKS, P.C.
600 Atlantic Avenue
Boston, Massachusetts 02210-2206
617.646.8000